

### **REMARKS**

This Amendment is responsive to the Office Action mailed August 11, 2006. After entry of this Amendment, claims 1-9, 12-30 are currently pending in this application. Claims 14-16 were previously withdrawn from consideration. Claims 1-9, 13, and 17-30 are subject to examination. Claims 10-12 are canceled without prejudice or disclaimer. Claims 1-6, and 8 have been amended and claims 25-30 have been added. Support for these amendments and new claims is found throughout the specification and in the claims as originally filed. The limitations of canceled claims 10 and 11 have been incorporated into amended claim 1, support for which is found at page 6, lines 13-31 of the specification. The limitations deleted from amended claims 2, 4, 6, and 8 have been incorporated into new claims 26-30, support for which is found at page 3, line 36 to page 4, line 21 and page 5, line 13 to page 6, line 9 of the specification. Support for the amendments to claims 3 and 5 is found at page 3, line 36 to page 4, line 19 of the specification. No new matter has been added.

Reconsideration of the application as amended is respectfully requested in view of the following remarks.

#### **Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 2-6, 8, 11, and 21 as indefinite. The Examiner rejected (1) claims 2, 4, 6, and 8 for use of the term “preferably”; (2) claims 3 and 5 for not stating a basis for the recited percentage by weight amounts; and (3) claims 11 and 21 for insufficient antecedent basis for the limitation “the total amount of polyvinyl alcohol in the dispersion.”

Claims 2, 4, 6, and 8 have been amended to delete the term “preferably” and the limitations to which this term referred have been incorporated into new dependent claims 26-30.

Claims 3 and 5 have been amended to specify that the recited percentage by weight amounts are based on the weight of the copolymer. As stated above, support for these amendments is found at page 3, line 36 to page 4, line 19 of the specification, which clearly



indicates that the percentage by weight amounts of these monomers are based on the weight of the copolymer of A).

As stated above, Claims 10 and 11 have been canceled and their limitations have been incorporated into claim 1. Thus, the above rejection is moot as to claim 11. Furthermore, the term "polyvinyl alcohol" is now recited in claim 1, since it contains the limitations incorporated from canceled claims 10 and 11. There is now sufficient antecedent basis for the limitation "the total amount of polyvinyl alcohol in the dispersion" in claim 21.

Applicants respectfully request withdrawal of these rejections.

#### **Rejection Under 35 U.S.C. 102(e)**

The Examiner rejected claims 1-13 and 17-24 under 35 U.S.C. § 102(e) as anticipated by U.S. Pat. App. Pub. No. 2005/0107515 to Jakob et al (hereinafter, "Jakob"). The Examiner alleges that Jakob teaches a food-coating composition comprising an aqueous copolymer polyvinyl ester dispersion which comprises, among other components, from 1 to 12 parts of polyvinyl alcohol. Since claims 10-12 have been canceled, these rejections are moot as to these claims. Applicants believe that claims 1-9, 13, and 17-24, as amended, and new claims 25-30 are novel and patentable over Jakob.

Claim 1 of the present application, as amended, reads as follows:

1. A food-coating composition comprising an aqueous copolymer poly(vinyl ester) dispersion which comprises
  - A) 100 parts by weight of a copolymer of from 40 to 95% by weight of vinyl esters of aliphatic saturated carboxylic acids, from 5 to 60% by weight of maleic esters and/or fumaric esters of monohydric aliphatic alcohols having a chain length of C<sub>1</sub>-C<sub>18</sub> and optionally other comonomers,
  - B) from 0.1 to 1.0 parts by weight of an emulsifier,
  - C) from 0 to 0.45 parts by weight of a cellulose ether,and



D) and an additional stabilizer consisting of 1 to 10% by weight of at least one polyvinyl alcohol having a degree of hydrolysis in the range from 85 to 90 mol % and a viscosity of its 4% by weight aqueous solution at 20 °C from 2 to 70 mPa·s.

As indicated in claim 1, as amended, the additional stabilizer of the aqueous copolymer poly(vinyl ester) dispersion may only **consist of** at least one polyvinyl alcohol having the degree of hydrolysis and viscosity limitations recited above. As a result of this closed language, amended claim 1 **excludes** mixtures of polyvinyl alcohols having degrees of hydrolysis different from the range recited therein. In contrast, the polyvinyl alcohol stabilizers of Jakob **must be a mixture** of at least two polyvinyl alcohols consisting of (1) at least one polyvinyl alcohol having a degree of hydrolysis of 85 to 90 mole percent and (2) at least one polyvinyl alcohol having a degree of hydrolysis of greater than 90 mole percent. (See paragraphs [0021] – [0023], [0028] – [0030], and [0049] – [0050] of Jakob) Thus, the polyvinyl alcohol stabilizer of Jakob must be a mixture of polyvinyl alcohols having different degrees of hydrolysis, a feature which claim 1, as amended, specifically excludes.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). By teaching that its polyvinyl alcohol stabilizers must be a mixture of polyvinyl alcohols having differing degrees of hydrolysis, Jakob fails to teach each and every element as set forth in claim 1, as amended. Thus, Applicant believes amended claim 1 is not anticipated by Jakob and is both novel and patentable over Jakob. Furthermore, since claims 2-9, 13, and 17-24 and new claims 25-30 depend either directly or indirectly from claim 1, which is deemed novel and patentable, Applicants believe these claims are also novel and patentable over Jakob.

Applicants respectfully request withdrawal of these rejections.

In view of the above amendment and remarks, Applicants believe the pending application is in condition for allowance.



Please charge our Deposit Account No. 03-2775, under Order No. 09600-00014-US \$150.00 for the three claims in excess of the 24 claims previously paid for by Applicants. Applicants believe no additional fees are due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 09600-00014-US from which the undersigned is authorized to draw.

Dated: November 13, 2006

Respectfully submitted,

Electronic signature: /Eamonn Morrison/  
Eamonn Morrison  
Registration No.: 55,841  
CONNOLLY BOVE LODGE & HUTZ LLP  
1007 North Orange Street  
P.O. Box 2207  
Wilmington, Delaware 19899  
(302) 658-9141  
(302) 658-5614 (Fax)  
Attorney for Applicant